



St 100 071

4300 Board of Appeals

B

Patent  
Attorney Docket: 201/260

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

David E. Holland et al.

Serial No.: 08/066,996

Filed: May 24, 1993

For: METHOD AND APPARATUS FOR  
IMPROVED SCANNING OF FILM

Group Art Unit: 2612

Examiner: Christiensen

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LETTER REGARDING SUSPENSION

Attention: Box Issue Fee  
Commissioner for Patents  
Washington, D.C. 20231

Sir:

In the Notice of Allowability dated March 29, 2001, prosecution was suspended for six months pending the possible declaration of an interference. While this case was identified as having potentially related claims, the interference was NOT declared with respect to the claims in this application. A copy of the Notice Declaring Interference is attached. It can be seen at page 5 that the sole application involved is 09/145,810. The undersigned can represent that this case was affirmatively called to the attention of APJ Jameson Lee, and was expressly excluded from being

OC-93089.1

CERTIFICATE OF MAILING  
(37 C.F.R. §1.8a)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231.

September 28, 2001  
Date of Deposit

Denise N. Doss

Name of Person Mailing Paper

Signature of Person Mailing Paper

designated as part of the interference. Applicant believes that the suspension should be lifted in this case, and the claims be allowed to proceed to issuance.

Respectfully submitted,

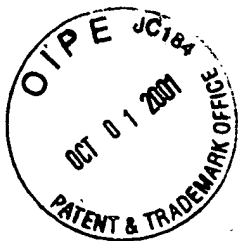
LYON & LYON LLP

Dated: September 28, 2001

By: 

David B. Murphy  
Reg. No. 31,125

DBM/dnd  
633 West Fifth Street, Suite 4700  
Los Angeles, California 90071-2066  
(949) 567-2300 or (213) 489-1600



The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 1

Filed by: Jameson Lee  
Administrative Patent Judge  
Box Interference  
Washington, D.C. 20231  
Tel: 703-308-9797  
Fax: 703-305-0942

Filed  
9 April 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

STEVEN SPEARS  
and DAVID WALKER

Junior Party,  
(Patent 5,666,156),

v.

DAVID E. HOLLAND and  
GAVIN W. SCHUTZ

Senior Party  
(Application 09/145,810)

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CALENDAR

Patent Interference No. 104,681

NOTICE DECLARING INTERFERENCE  
(37 CFR § 1.611)

Part A. Declaration of interference

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties.

Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in Parts E and F of this NOTICE DECLARING INTERFERENCE.

**Part B. Judge designated to handle the interference**

Administrative Patent Judge Jameson Lee has been designated to handle the interference. 37 CFR § 1.610(a).

**Part C. Standing order**

A Trial Section STANDING ORDER accompanies this NOTICE DECLARING INTERFERENCE. The STANDING ORDER applies to this interference.

**Part D. Conference call to set dates**

A telephone conference call to set dates for taking action in the interference is scheduled for 10:00 a.m. on May 29, 2001 (the call will be initiated from the PTO).

No later than **two business days** prior to the conference call, each party shall file and serve by facsimile a list of the preliminary motions the party intends to file. See § 17 of the STANDING ORDER.

A copy of a "sample" order setting times for taking action during the preliminary motion phase of the interference accompanies this NOTICE DECLARING INTERFERENCE.

Counsel are encouraged to discuss the order prior to the conference call with the view to coming to some mutual agreement as to dates for taking action. A typical preliminary motion period lasts approximately nine (9) months. Counsel should be prepared to justify any request for a shorter or longer period.

**Part E. The parties involved in this interference are:**

Junior Party

Named inventors: Steven Spears, San Dimas, CA  
David Walker, Glendora, CA

Patent: 5,666,156, issued 9 September 1997  
based on application 08/418,371,  
filed 7 April 1995

Title: System and method to improve the quality  
of reproduced images on a film to video  
transfer device

Assignee: None

Accorded Benefit: None

Attorneys: See last page

Address: See last page

Senior Party

Named Inventors: David E. Holland, Grand Hills, CA  
Gavin W. Schutz, Glendale, CA

Application: 09/145,810, filed 2 September 1998

Title: Method and apparatus for improved  
scanning of film

Assignee: Image Transform, Inc.

Accorded Benefit: 08/066,996, filed 24 May 1993

Attorneys: See last page

Address: See last page

Part F. Count and claims of the parties

Count 1

Claim 21 of Application 09/145,810

or

Claim 3 of Patent No. 5,666,156

The claims of the parties are:

Spears: 1-12

Holland: 21-22

The claims of the parties which correspond to Count 1 are:

Spears: 1-3 and 5-12

Holland: 21-22

The claims of the parties which do not correspond to Count 1 are:

Spears: 4

Holland: None

**Part G. Heading to be used on papers**

The following heading shall be used on papers filed in the interference. See § 18 of the STANDING ORDER.

---

Paper \_\_\_\_<sup>1</sup>

Filed on behalf of [name of party]

By: Name of lead counsel, Esq.

Name of backup counsel, Esq.

Street address

City, State, and Zip-Code

Tel:

Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Administrative Patent Judge Jameson Lee)

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STEVEN SPEARS  
and DAVID WALKER

Junior Party,  
(Patent 5,666,156),

v.

DAVID E. HOLLAND and  
GAVIN W. SCHUTZ

Senior Party  
(Application 09/145,810).

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Patent Interference No. 104,681

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TITLE OF PAPER

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<sup>1</sup> Leave a blank line because the board assigns the paper number.



**Part H. Summary of dates for taking action**

Times for taking action are set out in the following sections of the STANDING ORDER:

- 14 days* 1. § 7: date for identifying lead and backup counsel.
- 14 days* 2. § 8: date for identifying any real party in interest.
- 14 days* 3. § 9: date for requesting copies of involved and benefit applications and patents.
- May 27* 4. § 17: date for filing list of proposed preliminary motions.
- 20 days from reg by opp.* 5. § 19: date for accomplishing certain discovery.
- 14 days* 6. § 20: date for filing clean copy of claims.
- 28 days* 7. § 21: date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
8. § 23: dates for filing oppositions to Rule 635 miscellaneous motions and dates for filing replies to oppositions.
9. § 33: date for objecting to admissibility of evidence.
10. § 34: date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
11. § 35: dates when cross-examination can take place.
12. § 45: dates for taking action with respect to settlement discussions

**Part I. Order form for requesting file copies**

**FILE COPY REQUEST**

Interference 104,681

A copy of Part E of this NOTICE DECLARING INTERFERENCE should be attached to this FILE COPY REQUEST, with a circle by hand around the patents and applications for which a copy of a file wrapper is desired.

To facilitate processing of this FILE COPY REQUEST, the following information should be included:

1. Charge fees to USPTO Deposit Account No. \_\_\_\_\_
2. Complete address, including street, city, state, zip code and telephone number (do not list a Post Office box inasmuch as file copies are sent via commercial overnight courier).

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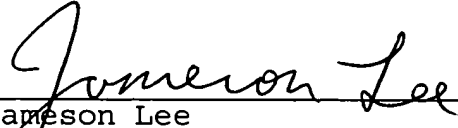
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Telephone, including area code: \_\_\_\_\_

Part J. Signature of administrative patent judge

  
Jameson Lee  
Administrative Patent Judge

Date: 4/9/01  
Arlington, VA

Enc:

Copy of STANDING ORDER

Copy of order used for setting times for taking action in  
the preliminary motion phase of the interference (ORDERPM6)

Copy of order used for setting times for taking action in  
the testimony and briefing phases of the interference  
(ORDERTE6)

PTO Form 850

Copy U.S. Patent 5,666,156

DECLARE.007  
Revised September 20, 2000  
(replaces DECLARE.006.1)

cc (via Federal Express):

Attorney for Spears:

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN  
12400 Wilshire Boulevard  
7th Floor  
Los Angeles, CA 90025

Attorney for Holland:

LYON & LYON  
611 W. Sixth Street  
34th Floor  
Los Angeles, CA 90017